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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,079	07/16/2003	Kenneth L. Levy	P0856	1849
23735	7590	07/24/2008	EXAMINER	
DIGIMARC CORPORATION			WILLIAMS, JEFFERY L	
9405 SW GEMINI DRIVE			ART UNIT	PAPER NUMBER
BEAVERTON, OR 97008			2137	
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			07/24/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/622,079	LEVY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JEFFERY WILLIAMS	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 01 May 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 30 and 36 – 55 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 30 and 36 – 55 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 16 July 2003 is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5-1-08..

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

This action is in response to the communication filed on 5/1/08.

All objections and rejections not set forth below have been withdrawn.

Claims 30, 36 – 55 are pending.

## *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show

10 every feature of the invention specified in the claims. Therefore, the added features of

11 “monitoring or analyzing a content item”, “a list of content items... comprising a subset  
12 of content items designated as active” “the list of content items being respectively

13. associated with one or more fingerprints derived from the content items themselves"

14 “deriving at least one fingerprint”, “each item on the list of content items being

15 respectively associated with one or more fingerprints derived from the respective

16 content item itself", "receiving a playlist, the playlist identifying ...", "based at least in

17 part on the playlist", "updating the list of content items by adding at least a plurality of

18 content items and removing at least a plurality of content items, but not all of the content

19 items from the list"; "deriving at least one fingerprint from a content item monitored or

20 analyzed from the network", "interrogating the list of content items with at least one

21 derived fingerprint", "receiving a list of content items, with each item on the list of

22 content items being associated with one or more fingerprints derived from the

1    *respective content item itself*", "adding and deleting entries in a table or data structure  
2    according to the list of content items"; "identifying a subset of the limited list of content  
3    items as active content items, the subset being associated with those content items  
4    being subject to updates"; "deriving at least one fingerprint from a content item  
5    monitored or obtained", "identify the monitored or obtained content item", "said act of  
6    deriving comprises deriving two or more fingerprints of the content item", and "said act  
7    of interrogating the list of content items utilizes the two or more fingerprints" must be  
8    shown or the feature(s) canceled from the claim(s). No new matter should be entered.

9            Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in  
10   reply to the Office action to avoid abandonment of the application. Any amended  
11   replacement drawing sheet should include all of the figures appearing on the immediate  
12   prior version of the sheet, even if only one figure is being amended. The figure or figure  
13   number of an amended drawing should not be labeled as "amended." If a drawing figure  
14   is to be canceled, the appropriate figure must be removed from the replacement sheet,  
15   and where necessary, the remaining figures must be renumbered and appropriate  
16   changes made to the brief description of the several views of the drawings for  
17   consistency. Additional replacement sheets may be necessary to show the renumbering  
18   of the remaining figures. Each drawing sheet submitted after the filing date of an  
19   application must be labeled in the top margin as either "Replacement Sheet" or "New  
20   Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,  
21   the applicant will be notified and informed of any required corrective action in the next  
22   Office action. The objection to the drawings will not be held in abeyance.

1

2 **Specification**

3

4 The abstract of the disclosure is objected to because the amendment of 5/1/08  
5 introduces new matter. See Objection to the Specification below. Correction is  
6 required. See MPEP § 608.01(b).

7

8 The specification is objected to as failing to provide proper antecedent basis for  
9 the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction  
10 of the following is required:

11        The specification fails to provide proper antecedent basis for the recitations of  
12        “monitoring or analyzing a content item”, “a list of content items... comprising a subset  
13        of content items designated as active”, “the list of content items being respectively  
14        associated with one or more fingerprints derived from the content items themselves”,  
15        “deriving at least one fingerprint”, “each item on the list of content items being  
16        respectively associated with one or more fingerprints derived from the respective  
17        content item itself”, “receiving a playlist, the playlist identifying ...”, “based at least in  
18        part on the playlist”, “updating the list of content items by adding at least a plurality of  
19        content items and removing at least a plurality of content items, but not all of the content  
20        items from the list”; “deriving at least one fingerprint from a content item monitored or  
21        analyzed from the network”; “interrogating the list of content items with at least one  
22        derived fingerprint”, “receiving a list of content items, with each item on the list of

1    *content items being associated with one or more fingerprints derived from the*  
2    *respective content item itself", "adding and deleting entries in a table or data structure*  
3    *according to the list of content items"; "identifying a subset of the limited list of content*  
4    *items as active content items, the subset being associated with those content items*  
5    *being subject to updates"; "deriving at least one fingerprint from a content item*  
6    *monitored or obtained", "identify the monitored or obtained content item", "said act of*  
7    *deriving comprises deriving two or more fingerprints of the content item", and "said act*  
8    *of interrogating the list of content items utilizes the two or more fingerprints".*

9

10                    ***Claim Rejections - 35 USC § 112***

11

12                    **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

13                    The specification shall contain a written description of the invention, and of the manner and process of  
14                    making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the  
15                    art to which it pertains, or with which it is most nearly connected, to make and use the same and shall  
16                    set forth the best mode contemplated by the inventor of carrying out his invention.

17

18                    **Claims 30, 36 – 55 are rejected under 35 U.S.C. 112, first paragraph, as**

19                    **failing to comply with the written description requirement.** The claim(s) contains  
20                    subject matter which was not described in the specification in such a way as to  
21                    reasonably convey to one skilled in the relevant art that the inventor(s), at the time the  
22                    application was filed, had possession of the claimed invention. Applicant has not  
23                    pointed out where the new (or amended) claim is supported, nor does there appear to  
24                    be a written description of the claim limitations in the application as filed (see above  
25                    objection to the specification).

1

2

3 ***Claim Rejections - 35 USC § 103***

4

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
6 obviousness rejections set forth in this Office action:

7 *(a) A patent may not be obtained though the invention is not identically disclosed or described as  
8 set forth in section 102 of this title, if the differences between the subject matter sought to be  
9 patented and the prior art are such that the subject matter as a whole would have been obvious  
10 at the time the invention was made to a person having ordinary skill in the art to which said  
11 subject matter pertains. Patentability shall not be negatived by the manner in which the invention  
12 was made.*

13

14

15 **Claims 30 and 36 – 55 are rejected under 35 U.S.C. 103(a) as being**  
16 **unpatentable over Schmelzer, “Copyright Detection and Protection System and**  
17 **Method”, U.S. Patent Publication 2003/0037010 in view of Razdan, “Real-time,**  
18 **Distributed, Transactional, Hybrid Watermarking Method to Provide Trace-ability**  
19 **and Copyright Protection of Digital Content in Peer-to-Peer Networks”, U.S.**  
20 **Patent Publication 2002/0168082.**

21

22 Regarding claim 30, Schmelzer discloses:  
23 *maintaining a limited list of content items, the list comprising a subset of content*  
24 *items designated as active, the list of content items being respectively associated with*

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1       *one or more fingerprints derived from the content items themselves* (par. 6, 7, 34 –  
2       herein it is shown that the list comprises registered and actively monitored copyrighted  
3       works, a subset of all copyrighted works);

4               *deriving at least one fingerprint from a content item monitored or analyzed from*  
5       *the network; and interrogating the limited list of content items with at least one*  
6       *fingerprint to identify the monitored content item* (par. 34)

7       Schmelzer does not appear to explicitly disclose that a network within a content  
8       fingerprinting system may comprise broadcast network. Razdan discloses that  
9       fingerprinting systems may comprise broadcast networks that broadcast content (par.  
10      32, 37, 38). It would have been obvious to recognize the broadcasting features as  
11      found within prior art fingerprinting systems such as Razdan within the fingerprinting  
12      system of Schmelzer. This would have been obvious because one of ordinary skill in  
13      the art would have been motivated by the advantages of a more flexible and socially  
14      relevant system.

15

16       Regarding claims 36 – 55, they are rejected, at least for the same reasons as  
17      claim 30, and furthermore because the prior art combination enables the features of  
18      *receiving a list of content items...storing the list of content items in a table or data*  
19      *structure; receiving a content item, the content item comprising audio or video; deriving*  
20      *a fingerprint from the content item itself...communicating a signal representing at least*  
21      *the identified content item to a remote device* (Schmelzer, par. 33, 34, 79; fig. 1:121,  
22      123; par. 47), “*updating the list of content items by adding at least a plurality of content*

1 *items and removing at least a plurality of content items, but not all of the content items*  
2 *from the list*” and “*adding and deleting entries in a table or data structure according to*  
3 *the list of content items*” (Schmelzer, par. 67, 83 – herein content items are enabled to  
4 be updated - it is noted that it was well known by those of ordinary skill in the art that  
5 updating may comprise removing information) “*deriving at least one fingerprint from a*  
6 *content item monitored or analyzed from the network*”; “*receiving a list of content items,*  
7 *with each item on the list of content items being associated with one or more*  
8 *fingerprints derived from the respective content item itself*”, “*interrogating the list of*  
9 *content items with at least one derived fingerprint*”, “*said act of deriving comprises*  
10 *deriving two or more fingerprints of the content item*”, “*said act of interrogating the list of*  
11 *content items utilizes the two or more fingerprints*” (fig. 2, 4, 6 - herein a plurality of  
12 identifiers (“fingerprints”) are derived and used for identifying listed content items).

13

14

## ***Response to Arguments***

16

17           Applicant's arguments with respect to the pending claims have been considered  
18           but are moot in view of the new ground(s) of rejection.

19

20           Applicant's arguments filed 4/30/08 have been fully considered but they are not  
21           persuasive.

22

1           Applicant argues essentially that:

2

3       (i)    *Claim 30 in view of Schmelzer and Razdan* *Claim 30 recites - in combination with*  
4   *other features - maintaining a list of content items. The list includes a subset of content*  
5   *items designated as active. The list of content items being respectively associated with*  
6   *one or more fingerprints derived from the content items themselves. The cited passages*  
7   *of Schmelzer and Razdan are not understood to anticipate or render obvious such a*  
8   *combination.*

9           *Claim 36 recites - in combination with other features - maintaining a list of*  
10   *content items, the list of content items being respectively associated with one or more*  
11   *fingerprints derived from the content items themselves. The method further recites*  
12   *receiving a playlist, the playlist identifying content items to be transmitted through the*  
13   *network during a predetermined time period; and based at least in part on the playlist,*  
14   *updating the list of content items by adding at least a plurality of content items and*  
15   *removing at least a plurality of content items. The cited passages of Schmelzer and*  
16   *Razdan are not understood to anticipate or render obvious such a combination.*

17           *Claim 38 recites - in combination with other features - receiving a list of content*  
18   *items, the list of content items is respectively associated with one or more fingerprints*  
19   *derived from the content items themselves; and adding and deleting entries in a table or*  
20   *data structure according to the list of content items. The cited passages of Schmelzer*  
21   *and Razdan are not understood to anticipate or render obvious such a combination.*

1        *Claim 40 recites - in combination with other features - maintaining a limited list of*  
2    *content items, the list of content items being respectively associated with one or more*  
3    *fingerprints derived from the content items themselves; and identifying a subset of the*  
4    *limited list of content items as active content items, the subset being associated with*  
5    *those content items being subject to updates. The cited passages of Schmelzer and*  
6    *Razdan are not understood to anticipate or render obvious such a combination.*

7    (Remarks, pg. 7, 8)

8

9        In response, the examiner notes that the applicant appears to essentially argue  
10   that the prior art fails to disclose updating a database or list (the database or list being  
11   updatable, and the updating comprising adding and removing information), content  
12   items being a subset and designated as active, and a plurality of fingerprints associated  
13   with a content item and used for analysis.

14        However, the examiner respectfully notes that the prior art enables for a  
15   database or list of content items to be updatable (Schmelzer, par. 67, 83), and the  
16   examiner points out that it was well known to those of ordinary skill that updating  
17   information may comprise removing or adding information. Furthermore, the content  
18   items within the list are a subset of all copyrighted works and are designated as "active"  
19   to be monitored (Schmelzer par. 6, 7, 34). Finally, a plurality of identifiers or  
20   "fingerprints" are associated with a content item and is used in analysis (Schmelzer, fig.  
21   2, 4, 6).

22

1 **Conclusion**

2

3 The prior art made of record and not relied upon is considered pertinent to  
4 applicant's disclosure:

5 See Notice of References Cited.

6

7       Applicant's amendment necessitated the new ground(s) of rejection presented in  
8 this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP  
9 § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37  
10 CFR 1.136(a).

11 A shortened statutory period for reply to this final action is set to expire THREE  
12 MONTHS from the mailing date of this action. In the event a first reply is filed within  
13 TWO MONTHS of the mailing date of this final action and the advisory action is not  
14 mailed until after the end of the THREE-MONTH shortened statutory period, then the  
15 shortened statutory period will expire on the date the advisory action is mailed, and any  
16 extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of  
17 the advisory action. In no event, however, will the statutory period for reply expire later  
18 than SIX MONTHS from the date of this final action.

19 Any inquiry concerning this communication or earlier communications from the  
20 examiner should be directed to Jeffery Williams whose telephone number is (571) 272-  
21 7965. The examiner can normally be reached on 8:30-5:00.

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1        If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
2 supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone  
3 number for the organization where this application or proceeding is assigned is (703)  
4 872-9306.

5        Information regarding the status of an application may be obtained from the  
6 Patent Application Information Retrieval (PAIR) system. Status information for  
7 published applications may be obtained from either Private PAIR or Public PAIR.  
8 Status information for unpublished applications is available through Private PAIR only.  
9 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should  
10 you have questions on access to the Private PAIR system, contact the Electronic  
11 Business Center (EBC) at 866-217-9197 (toll-free).

12

13

14      J. Williams

15      AU: 2137

16

17      /Emmanuel L. Moise/

18      Supervisory Patent Examiner, Art Unit 2137